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TUCKER ELLIS & WEST LLP 1150 HUNTINGTON BUILDING 925 EUCLID AVENUE CLEVELAND, OH 44115-1414			EXAMINER NGUYEN, THUY-VI THI	
			ART UNIT 3689	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/816,653

Applicant(s)

SINGH ET AL.

Examiner

THUY VI NGUYEN

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-9, 11-16, 23 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 11-16, 23, 25-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date ____.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

1. This is in response to the applicant's communication filed on July 17, 2008, wherein:

Claims 1, 3-9, 11-16, 23, 25-28 are currently pending;

Claims 2, 10, 17-22 and 24 have been cancelled;

Claims 1, 9, 23, have been amended.

Claim 9 is amended as follow:

(Currently amended) A method for providing fee-based collaborative access to data stored on a shared data peripheral ~~devices~~-device comprising the steps of."

1) allocating a selected storage area in a secure data storage medium;

2) receiving login data corresponding to an identity of an associated user;

3) receiving, from the associated user, formatting data corresponding to a format for storage of electronic document data;

4) communicating electronic document data from at least one data input/output device in a data peripheral system into the selected storage area of secure data storage medium for storage in accordance with received formatting data;

5) securing charge information from an-the associated user, which charge information allows for securing of payment for use the data peripheral system;

6) securing charge verification information corresponding to charge information received from the associated user; and

7) enabling operation of the data peripheral system in accordance with an output of the verification means so as to provide fee-based access of the associated user to the peripheral system

8) receiving, from the associated user, an access control list corresponding to an identity of at least one user authorized to access data stored in the selected storage area of the secure data storage medium;

9) storing the access control list, which access control list dictates an identity of users authorized to access the data stored in the selected storage area of the secure data storage medium;

10) generating secure login data for each authorized user associated with the access control list;

11) communicating login information corresponding to secure login data to each authorized user;

12) receiving login data from the at least one authorized user;

13) testing received login data from the at least one authorized user against the access control list; and

14) communicating data stored in the selected storage area of the secure data storage medium to the at least one authorized user in accordance with an output of the testing step.

Note: for convenience, number (1)–(14) are added to the beginning of each element.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3-9, 11-16, 23, 25-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has added limitations to this claims related to *"receiving, from the associated user, an access control list (step 8); testing received login data (step 13)*. Examiner has reviewed applicant's disclosure and submits that this added limitation finds no support in the specification as currently written and is, therefore, directed to new matter. Applicant's specification appears to teach storing an access control list, which access control list dictates an identity of users authorized

to access data stored in the selected storage area of the secure data storage medium. However, examiner submits that these teachings do not provide adequate support for the claim language of claims 1, 9 and 23 as currently amended. Applicant's specification provides no teaching or disclosure of "receiving, from the associate user, an access control list and the testing feature as stated above.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3-9, 11-16, 23, 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As for independent claims 1, 9, and 23, the preamble stated " *a system, method , computer implement method for providing collaborative access to data stored on a shared data peripheral device*" . However, the limitation in the body of the claim does not clarify how the "collaborative access" feature is carried out.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

Art Unit: 3689

patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4-8, 9, 12-16, 23, 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamada (US 7,254,606) in view of Clymer et al. (US 7,225,263)

As for claim 9 Hamada discloses a method for providing fee-based collaborative to data stored on a shared data peripheral device comprising the steps of:

1) allocating a selected storage area in a secure data storage medium [...i.e. *sending the data with the data storage request to the selected data server, and store the data in the select data server*; abstract; and figures 2 and 15];

2) receiving login data corresponding to an identity of an associated user {...receive the user authentication; see col. 6, lines 1-13, col. 10, lines 41-50, figures 11-12, and 20.};

3) receiving, from the user, formatting data corresponding to a format for storage of electronic document data [...*receiving data into a predetermined format* implies that formatting data would have been received beforehand from a user; see col. 5, lines 5-14];

4) communicating electronic document data from at least one data input/output device in a data peripheral system into the selected storage area of secure data storage medium for storage in accordance with received formatting data [...i.e. *network (10); sending the data associated with the data storage request*

to the selected data server via the communication line;; figures 1, 11 and 12; col. 1, lines 60-62; col. 3, lines 20-26; col. 4, lines 13-20];

5) securing charge information from the associated user, which charge information allows for securing of payment for use the data peripheral system [...i.e. charge process for a user to pay a fee for the use of data system; figures 24-25; col. 15, lines 33-60];

6) securing charge verification information corresponding to charge in formation received from the associated user [...i.e. sending a message indicating that the service subscription value has paid; col. 16, lines 32-42; figure 24, step (1823)];

7) enabling operation of the data peripheral system in accordance with an output of the verification means so as to provide fee-based access of the associated user to the peripheral system [...i.e. enabling the process of sending the requested storage data to data server from client terminal; and the process of receiving the data from the data server; col. 3, lines 1-6; col. 8, lines 32-67; col. 9, lines 1-2 and figures 2-3];

8) receiving, a data list corresponding to an identity of at least one user authorized to access data stored in the selected storage area of the secure data storage medium {see col. 6, lines 24-31 figures 5-7 for the storage data list that contain authorized user information; and see figure 4, col. 9, lines 14-40, discusses control server 111 accesses data servers that store user data to be checked;}

9) storing the data list, which dictates an identity of users authorized to access the data stored in the selected storage area of the secure data storage medium {see col. 6, lines 24-31 figure 7 discusses *the storage data list that contain authorized user information*; and see figure 4, col. 9, lines 14-40, control server 111 accesses data servers that store user data to be checked;}

10) generating secure login data for each authorized user associated with the access control list {see figures 3 and 18, col. 8, lines 33-67, col. 9, lines 1-7, discusses the generating the user authentication process for accessing user data stored in the data server}

11) communicating login information corresponding to secure login data to each authorized user {see figures 11-12, 18 col. 9, lines 3-7; col. 10, lines 41-67; col. 13, lines 40-67 *discusses the communication line between the client terminal (user) and the control server 111 for accessing to the data server; receiving login data from the at least one authorized user*};

13) testing received login data from the at least one authorized user against the access control list {see figures 11-12, 18, col. 10, lines 41-67; e.g. *user authentication is checked if the user level recognized* }; and

14) communicating data stored in the selected storage area of the secure data storage medium to the at least one authorized user in accordance with an output of the testing step {see figures 1,3 and 18, col. 8, lines 35-67; col. 9, lines 1-8; col. 13, lines 43-45 *discusses a communication process executed upon reading*

out user data saved in the data servers 112 and 113 and outputting the readout data by the remote printer 121}.

Hamada discloses all the limitation as stated above, Hamada further discloses receiving and storing the data list corresponding to an identity of at least one user authorized {see col. 6, lines 24-31 figure 7 discusses *the storage data list that contain authorized user information*}. However, Hamada does not mention about "receiving, from the associated user (step 12), an access control list corresponding to an identity of at least one user authorized from the associated user" step 9.

In the similar method for accessing information from the storage medium or server through the network, Clymer et al disclose receiving, from the associated user, an access control list, and storing an access control list corresponding to an identity of at least one user authorized from the associated user {see abstract, figure 2A, col.3, lines 24-32; e.g. received an access control list that is associated with a user of the network devices; and see figure 1, col. 4, lines 24-27, for the storing the access control list on the authentication server 120.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method and system of Hamada to include the access control list feature as taught by Clymer in order to provide the better solutions that supports network access information, to provide efficient user of device memory. {Clymer, col. 2, lines 14-28}

Note: As for the claimed "collaborative access feature". It is not given patentable weight since it is not in the body of the claim. However the examiner notes that it would have been obvious to one of ordinary skill in the art to incorporate this feature in the claim invention since the "collaborate feature" is old and well known in the art.

As for claim 12, Hamada discloses the data peripheral system includes at least one of a printer, facsimile, scanning device, character recognition system, and storage device [...figure 1].

As for claim 13, Hamada discloses the step of selecting parameters for a selected data processing operation undertaken in connection with the data stored in the secure data storage medium [...i.e. *user select a data server in which he or she want to store data*; col. 6, lines 9-13; col. 12, lines 62-66 and figure 14];

As for claim 14, Hamada discloses the charge information includes information associated with at least one of a pre-paid debit card, coupon, and credit card [...*debit card or credit card*; col. 17, lines 3-9].

As for claim 15, Hamada discloses the step of tracking the user's usage of the data peripheral system and generating a cost for the user's usage of the data peripheral system [...i.e. *control server 111 and IC card 124 manage user's information such as charge information, various kinds of information with the storage data servers*; col. 16, lines 45-52; and figures 1, 22 and 24].

As for claim 16, Hamada discloses the step of applying the generated cost to the user's charge information [...i.e. *calculating the value of data usage, and then*

send to the user; and then send the message to the server of the use's bank to designates the amount to be paid; col. 15, lines 5560; col. 16, lines 4-8; lines 22-24; lines 32-35; figure 24].

As for independent claim 1, Hamada discloses a system for providing fee based access to data stored on a shared data peripheral device comprising: a data peripheral system with at least one data input/output device, a secure data storage medium {see figure 1}. Basically, the claim deals with the means functions that carry out the method step of the independent claim 9. It is rejected for the same reason sets forth independent claim 9 stated as above.

As for dependent claims 4-8 which deal with a system that carries out the method steps of the dependent claims 12-16 above. They are rejected for the same reason sets for the dependent claims 12-16 stated above.

As for independent claim 23 which deals with a computer-implement that carries out the method step of the independent claim 9 above. It is rejected for same reason sets forth the independent claim 9 stated above.

As for dependent claims 26-28 which deals with a computer implement method that carries out the method steps of the dependent claims 6-8. They are rejected for the same reason sets forth the dependent claims 6-8 above.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3,11, 19, 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Hamada in view of Clymer et al. (US 7,225,263) and further in view of Aoyagi (US 2003/0071900).

As for claims 3, 11, 19, 25, Hamada/Clymer discloses the claim invention as stated above. However, Hamada doesn't explicitly disclose means adapted for selectively de-allocating the selected storage area in the secure data storage medium after expiration of a pre-selected duration.

Aoyagi discloses means adapted for selectively de-allocating the selected storage area in the secure data storage medium after expiration of a pre selected duration [...i.e. the image data to be deleted/de-allocated based on the order of the image data retention dates; par. 0055; abstract and figure 7].

Therefore, It would have been obvious in one of ordinary skill in the art at the time of the invention to incorporate the allocating the image data in a storage medium of Hamada/Clymer to include the method of de-allocating the image data as taught by Aoyagi in order to reduced the storage capacity medium as well as reducing the customer usage's charge.

Response to Arguments

10. Applicant's arguments filed 07/17/08 have been fully considered but they are not persuasive. Applicant's arguments with respect to claims 1, 3-9, 11-16, 23, 25-28 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's arguments, the recitation "*collaborative document*" feature has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's argument (page 11 of the remark) that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*document sharing system that alleviates the problem associated with sharing documents, such as large documents*") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993).

Conclusion

11. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information As for the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689